

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : To be determined Confirmation No.
Orig Pat No. 6,369,116
Applicant : WONG et al.
Filed : Herewith
Title : COMPOSITION AND METHOD FOR TREATING GLAUCOMA

TC/A.U. : NA
Examiner : NA

Docket No. : D-3136 CON1 CIPRE
Customer No. : 33197

Mail Stop REISSUE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION UNDER 37 C.F.R. § 1.47(b)

Dear Sir:

Applicant's undersigned attorney is submitting this petition in the above-identified reissue patent application because one of the inventors, Vernon Wong (hereinafter Dr. Wong), in the above-identified reissue patent application refuses to execute the Declaration and Petition for Reissue Application accompanying the reissue patent application enclosed herewith. This petition is being submitted along with unsigned copies of the Declaration and Petition for Reissue Application, and the Offer to Surrender that were sent to the inventors of the above-identified reissue patent application.

Applicant respectfully requests that this petition be granted, and that the owner (Allergan, Inc.) of the above-identified reissue patent application be permitted to proceed with the examination of the above-identified reissue patent application.

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I. Facts

One of the inventors, Dr. Wong, named in the above-identified reissue patent application refuses to execute the Declaration and Petition for Reissue Application and the Offer to Surrender that are required to file a reissue patent application. Applicant has made a diligent effort in attempting to obtain Dr. Wong's signatures on the reissue documents submitted herewith. At least three different attempts were made to obtain signatures from Dr. Wong over a period of about two weeks. As of the filing of this application, the executed documents have not been received from Dr. Wong.

In support of these facts, applicant provides the following:

1. On March 19, 2004, Stephen Donovan, Esq. (Senior Patent Attorney for Allergan, Inc. and identified as of record in this application) spoke with Dr. Wong by telephone. During that conversation, Dr. Wong agreed to look at the reissue documents. This is supported by an email from Mr. Donovan to Frank Uxa and Greg Hollrigel, which is submitted herewith as Exhibit 1.
2. On March 24, 2004, Mr. Donovan sent an email to Dr. Wong requesting Dr. Wong's assistance in reviewing and signing the appropriate documents needed to file the above-identified reissue patent application. The documents that were attached to the email were: (i) a Preliminary Amendment; (ii) a Declaration for Reissue; (iii) an Offer to Surrender; and (iv) a copy of U.S.

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Patent No. 6,369,116. This email is submitted herewith as Exhibit 2.

3. On March 25, 2004, Mr. Donovan sent a letter to Dr. Wong via Federal Express requesting Dr. Wong's assistance in reviewing and signing the above-referenced documents. A copy of this letter is attached as Exhibit 3.
4. On March 25, 2004, Dr. Wong sent an email to Mr. Donovan indicating that he received the four files sent with the March 24, 2004 email, and that he was returning the four files to Mr. Donovan by email without signing the documents. In addition, the email indicates that he will return the original documents without signature. Dr. Wong also stated he believed that the patent Mr. Donovan was referring to (U.S. Patent No. 6,369,116) was no longer his property. A copy of that email is provided at the bottom of Exhibit 4.
5. On March 26, 2004, Mr. Donovan's letter sent by Federal Express was delivered to Dr. Wong at his residence as evidenced by the shipment results submitted herewith as Exhibit 5.
6. On March 30, 2004, Mr. Donovan sent another email to Dr. Wong along with (i) the Preliminary Amendment; (ii) the Declaration for Reissue; (iii) the Offer to Surrender; and (iv) the copy of U.S. Patent No. 6,369,116. This email was sent since the signed documents were not received from Dr. Wong. A copy of this email is submitted herewith as Exhibit 6.

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7. On April 2, 2004, Dr. Hollrigel of the undersigned's office sent a letter to Dr. Wong via Federal Express along with copies of (i) U.S. Patent No. 6,369,116; (ii) the Declaration and Petition for Reissue Application; (iii) the Offer to Surrender; and (iv) the Preliminary Amendment. In addition, a prepaid self-addressed Federal Express envelope was enclosed for Dr. Wong's convenience. The letter indicated that Dr. Hollrigel requested the executed documents be returned by April 7, 2004. A copy of the April 2 letter and the four enclosures is submitted herewith as Exhibit 7.
8. On April 5, 2004, Dr. Hollrigel's April 2 letter was delivered to Dr. Wong's residence. Proof of delivery is submitted herewith as Exhibit 8.
9. As of April 7, 2004, neither Mr. Donovan's office nor the undersigned's office has received the signed documents from Dr. Wong. This is evidenced by the two shipment tracking results submitted herewith as Exhibit 9. The airbill number for delivery to Allergan, Inc. is 835864856563. The airbill number for delivery to the undersigned's office is 823079673318.

In view of the above, applicant submits that applicant has been diligent in attempting to obtain Dr. Wong's signatures. At least three separate attempts were made requesting Dr. Wong's cooperation and assistance in executing documents required with the filing of the above-identified reissue patent application. In view of the facts that Dr. Wong indicated he would return the

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documents unopened and unsigned (see Exhibit 4) and that the signed documents have not been received either by Mr. Donovan or the undersigned's office, applicant submits that Dr. Wong refuses to execute the documents necessary for the above-identified reissue patent application.

II. Proof of Proprietary Interest

Applicant submits that the above-identified reissue patent application has been assigned to Allergan, Inc. by way of the assignment of the original patent, U.S. Patent No. 6,369,116. The application which issued as U.S. Patent No. 6,369,116 was assigned by inventors, Vernon Wong and Lin Peng, to Oculex Pharmaceuticals, Inc. as evidenced by the assignment recorded at Reel 9849, Frame 0520. U.S. Patent No. 6,369,116 was subsequently assigned by Oculex Pharmaceuticals, Inc. to Allergan, Inc. A copy of the assignment submitted to the United States Patent and Trademark Office on January 8, 2004 is submitted herewith along with the Offer to Surrender and Consent of Assignee as Exhibit A. The Offer to Surrender includes a Statement Under 37 C.F.R. § 3.73(b).

III. Proof of Irreparable Damage

Applicant submits that a filing date no later than April 9, 2004 is necessary to preserve the rights of the owner (Allergan, Inc.) of the above-identified reissue patent application. Failure to file this reissue application on or before April 9, 2004, as required by 35 U.S.C. § 251, would result in irreparable damage to applicant.

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IV. Fee under 37 C.F.R. § 1.17(h)

The Commissioner is hereby authorized to charge the fee under 37 C.F.R. § 1.17(h) as required with the submission of this petition to Deposit Account No. 01-0885.

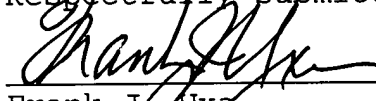
V. Last known address of Dr. Vernon Wong

Dr. Vernon Wong
180 Sand Hill Circle
Menlo Park, CA 94025

Applicant submits that this petition satisfies the requirements of 37 C.F.R. § 1.47(b), and respectfully requests that this petition be granted.

Date: 4/8/04

Respectfully submitted,



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